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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,376	02/27/2002	Daisuke Miyakoshi	112066	4770

25944 7590 07/18/2006

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EXAMINER


TO, TUAN C

ART UNIT PAPER NUMBER

3663

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Number 	Application/Control No. 10/083,376 Jack W. Keith	Applicant(s)/Patent under Reexamination MIYAKOSHI ET AL. Art Unit 3663
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 6/30/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-2, 6-7, 10, 22, and 23.

Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Jack W. Keith, SPE.

(2) Tom Black, SPE.

(3) Tuan To, Examiner.

(4) _____.



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Daisuke MIYAKOSHI et al.

Group Art Unit: 3663

Application No.: 10/083,376

Examiner: T. TO

Filed: February 27, 2002

Docket No.: 112066

For: PORTABLE INFORMATION TERMINAL AND CONTROL METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicants respectfully request review of the Final Rejection mailed March 30, 2006, in the above-identified application.

I. Status of Pending Claims

Claims 1-2, 6-7, 10, 22 and 23 are pending. Claims 1-2, 6-7, 10, 22 and 23 are rejected. An Amendment is being filed with this request. The Amendment cancels claims 4-5, 8, and 11-12. The Amendment does not otherwise amend the pending claims.

II. Grounds of Rejection Presented For Review

The following grounds of rejection are presented for review: claims 1-2, 6, 10, 22 and 23 are rejected under 35 U.S.C. §102(a) over U.S. Patent Publication No. 2001/0055974 to Bates et al. (Bates); claim 7 is rejected under 35 U.S.C. §103(a) over Bates in view of U.S. Patent No. 6,049,718 to Stewart. However, Bates does not anticipate claims 1-2, 6, 10, 22 and 23. Claims 1 and 23 are the rejected independent claims, and these rejections are the only

rejections of claims 1, 2, 6, 7, 10, 22 and 23. The following grounds of rejection are presented for review:

Regarding claim 1, Bates fails to disclose "the information notification unit notifies a user of the portable information terminal of information derived from the extracted data without any instruction made by the user." The extracted data, as recited, is "data [extracted] on the current received location information from among data stored in the storage unit." This stored data is correlated with last location information received from the receive unit ("the data being correlated with last location information received by the receive unit").

The Office Action alleges that Bates teaches notifying a user of information derived from extracted data at paragraph [0041] (method 600) by disclosing that the phone display prompts for boundary points of the region before requiring further input when the user is in a specific region. The Office Action is incorrect. The prompts displayed to the user are simply indications to the user that the user should provide input defining the boundary of the region. These prompts are not data, let alone data that was earlier correlated with a last location information and stored.

As disclosed by Bates, a user can define regions and set different phone parameters for each region (paragraph [0036]). This allows the telephone system to have "a different function depending on the region the phone is in" (paragraph [0035]). A user can define regions by manually inputting GPS coordinates (paragraph [0037]); downloading GPS coordinates from a mapping service (paragraph [0037]); walking the boundary (*e.g.* method 600) (paragraph [0038]), or by defining a radius based on a detected center point (paragraph [0040]).

Method 600, cited by the Office Action and shown in Fig. 6, discloses allowing a user to dynamically define a region of interest. Once initiated (Fig. 6, start step), the phone prompts the user for a boundary point (step 610). The user then goes to a boundary point (a

physical location) (step 620), presses a button (step 630), and the phone stores the boundary point (step 640). This process is repeated until the user is satisfied that all boundary points are input (step 650).

Method 600, Fig. 6, or paragraph [0041] do not teach the recited notification of a user by "information derived from the extracted data without any instruction made by the user" because (1) no extracted data correlated to the current location information is presented to the user, (2) method 600 is not initiated "when received location information is different from last received location information," but rather it is the user that initiates method 600 and, thus, any display associated with it (Fig. 6, start step).

For at least the forgoing reasons, Bates does not teach all the features of claim 1. As Bates does not teach all of the features of claim 1, claim 1 is patentable over Bates. Further, the rejection of pending claims 2, 6, 7, 10 and 22 is based on the presumption that Bates discloses all the features of claim 1. As Bates does not disclose all the features of claim 1, these claims also are patentable.

Regarding claim 23, Bates fails to disclose "the information notification unit notifies a user of information derived from the extracted data without any instruction made by the user." The extracted data is "data [extracted] on the current received location information from among data stored in the storage unit."

The Office Action alleges that the display 130 somehow teaches the notification of the user. The Office Action is incorrect.

Bates does not disclose that notification is presented to the user when the position detector 220 detects that the phone has entered a new region but only that the telephone system may have different functions (paragraph [0036]). Thus, Bates does not teach notification of a user with information derived from stored and correlated data because a change in function is not a notification. Even if a change in function were considered

In Bates et al., without any instruction made by the user, when the portable phone is within a defined region, the portable phone rings to illustrate "phone parameters"

notification, however, Bates still does not disclose all the features of claim 23 because the user would not know of the altered functionality until the user made use of the phone. Thus, even if a change in function is considered a notification, Bates fails to teach "notifies a user of information derived from the extracted data without any instruction made by the user."

The Office Action rejects claim 7 under 35 U.S.C. §103(a) over Bates in view of U.S. Patent No. 6,049,718 to Stewart. Applicants respectfully traverse the rejection.

This rejection is based on the presumption that Bates discloses all the features of claim 1. As Bates does not disclose all the features of claim 1, the rejection is improper.

For the foregoing reasons, Applicant respectfully submits that Bates does not disclose the combination of features recited independent claims 1 and 23 or any of the claims dependent therefrom. Reconsideration and withdrawal of the rejections are thus respectfully requested.

III. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that all the pending claims are in condition for allowance. Applicants respectfully request the panel of Examiners to review the March 30, 2006 Final Rejection prior to Appeal and to withdraw the rejections.

Respectfully submitted,



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JAO:JHB/tje

Date: June 30, 2006

Attachment: Notice of Appeal

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